

REMARKS

Claims 1-16 are pending.

Claims 1 and 15 are independent claims from which the remaining claims depend either directly or through intervening claims.

Drawings

It is assumed that the drawings have been accepted, although no comment was made on the PTOL-326, Section 10, on this matter.

Foreign Priority

The notation that the foreign priority documents have been received and placed in the file is noted.

Abstract

A new abstract has been provided to be more in compliance with U.S. practice.

The Examiner is requested to approve the new abstract.

Reply to Rejections

First Rejection

On page 2 of the Office Action, claims 5 and 12 were rejected under 35 U.S.C. § 112, and also a notation that the claim should be rewritten has been noted.

The claims have been amended to be more in compliance with U.S. practice and to overcome the rejection of claims 5 and 12.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 112.

Second Rejection

Claims 1-5, 7, and 15-16 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kawamura et al. (USPN 6,409,513; hereinafter “Kawamura”). This rejection is traversed.

In rejecting the claims under 35 U.S.C. § 102, the Examiner’s detailed explanation and reference to the patent are appreciated and does expedite prosecution.

With respect to the details of the rejection, for example in base claims 1 and 15, the Examiner relies on column 4, lines 34-58 regarding the number of characters which are required in each exercise. A reference to this portion of the patent is as follows:

The first step is to select the reading material from the column of titles 54. The cursor is moved over a box to make a section. The reader must then select whether to read at a pace set by the reader, or one set by the software program. If the reader lets the software program set the reading pace, the reader is able to select the column width (words per line), font size (size of words), block size (number of lines highlighted) and the speed (words per minute) at which the software will move. It is noted that an important and novel feature of the present invention is the ability to customize the features described above. This ability to customize enables the reader to maintain the maximum degree of comfort while still pushing the reader to new levels of reading speed and comprehension.

A review of this portion of the patent does not specifically or inherently disclose what has been claimed with respect to the number of characters which is required in each of the exercises.

As each and every limitation of the base claims 1 and 15 is not shown either specifically or inherently in the reference, a rejection under 35 U.S.C. § 102 is not viable.

Even if this feature was a possibility or probability, which it is not, a rejection under 35 U.S.C. § 102 cannot be based on possibility or probability. See Continental Can Co. USA Inc. v. Monsanto, 20 USPQ 2nd, 1746, 1749, 1750 (Fed. Cir. 1991) which stated as follows:

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled...[such] that the missing...matter is necessarily present in the...reference, and that it would be so recognized by persons of ordinary skill..."Inherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient...

With respect to the dependent claims which are dependent on the base claims. These claims are considered patentable at least for the same reasons as their base claims.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 102

Third Rejection

Claims 8-12 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kawamura et al. (USPN 6,409,513; hereinafter "Kawamura"). This rejection is traversed.

The Examiner at least recognizes that the reference does not show the features in these claims but asserts "however, it is the Examiner's position that the use of an information communication network is old and well known in the art for providing training information to users located at remote locations in order to overcome geographical limitations." Even assuming *arguendo* that the Examiner's statement is correct, what the Examiner has done is merely concentrated on the individual parts and not the combination as a whole. There is no *prima facie* case of obviousness established. Even though the parts may be known, this does not establish obviousness of the invention as a whole. See Ruben Condenser Co. v. Copeland Refrigeration Corporation that states as follows:

We do not of course forget that it is always the combination that counts, and that no patents, or almost none are made from new elements. 85 Fed. 2nd 537, 541, 31 USPQ 6, 6, (C.A. 2 1936).

See also Hybritech Inc. v. Monoclonal Antibodies Inc. 231 USPQ 81 (Fed. Cir. 1986) wherein the Court stated as follows:

Focusing on the obviousness of substitutions and differences instead of the invention as a whole...was a legally improper way to simplify the difficult determination of obviousness.

Also, from the tone of the rejection, it appears that the Examiner's position that one of ordinary skill in the art would be able to arrive at the invention. But this is not the test of obviousness. See Ex Parte Levingood 28 USPQ 2nd 1300 (BPAI 1993), wherein the Board stated as follows:

At best, the Examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at Appellant's invention because he had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness. (Emphasis added).

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 103

Fourth Rejection

Claims 6 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kawamura et al. (USPN 6,409,513; hereinafter "Kawamura"), in view of Tadlock et al. (USPN 6,869,287; hereinafter "Tadlock"). This rejection is traversed.

As set forth above, there is no *prima facie* case of obviousness. Again, the Examiner is concentrating not on the subject matter as a whole but on the individual parts. See the case cite above. Also, the Examiner's conclusion is unsupported by any direct evidence. The Tadlock reference does not cure the innate deficiencies of a rejection based on the first reference.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 103

Additional Art Cited

Additional art was cited but as it has not been applied, no further comments are considered necessary.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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